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**THIS DISPOSITION
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Paper No. 26
AD

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Boulevard Brewing Associates Limited Partnership,
d/b/a Boulevard Brewing Company

Serial No. 75/543,877

Dianne M. Smith-Misemer of Spencer Fane Britt & Browne LLP
for Boulevard Brewing Associates Limited Partnership, d/b/a
Boulevard Brewing Company.

Dawn J. Feldman, Trademark Examining Attorney, Law Office
111 (Craig Taylor, Managing Attorney).

Before Hanak, Walters and Drost, Administrative Trademark
Judges.

Opinion by Drost, Administrative Trademark Judge:

Boulevard Brewing Associates Limited Partnership,
d/b/a Boulevard Brewing Company (applicant) has applied to
register the mark shown below on the Principal Register for
goods identified as "beer, ale, and malt liquor" in
International Class 32.¹

¹ Serial No. 75/543,877 filed on August 27, 1998, claiming a date
of first use and date of first use in commerce of November 30,
1996. The application contains a disclaimer of the word "ale."



The Examining Attorney has refused to register the mark under Section 2(d) of the Trademark Act because of a prior registration for the mark NUTCRACKER in typed form for "liqueur" in International Class 33.² 15 U.S.C. § 1052(d).

After the Examining Attorney made the refusal final, this appeal followed. Both applicant and the Examining Attorney filed briefs. An oral hearing was not requested.

After considering the arguments and papers of the applicant and the Examining Attorney, the Examining Attorney's refusal to register applicant's mark for the goods identified in the application because it is confusingly similar to the registered mark NUTCRACKER for liqueur under Section 2(d) is affirmed.

The Examining Attorney's position is that the term NUT CRACKER is the dominant element of applicant's mark, and it

² Registration No. 1,364,826, issued October 8, 1985. Section 8 and 15 affidavits have been accepted or acknowledged. The original registrant, Glenmore Distillers Company, subsequently assigned the registration. USPTO records reflect that the current owner is Barton Incorporated. See Reel/Frame Nos. 1042/0060 and 1407/0754.

is virtually identical to registrant's mark. The goods of the parties are also related in that they are both alcoholic beverages that would be sold through some of the same stores, and consumers "may believe that the goods emanate from the same source." Examining Attorney's Appeal Br., p. 6.

Applicant, on the other hand, argues that the cited registration has been abandoned and that the distinctive design of applicant's mark "vitiates any likelihood of confusion." Applicant's Appeal Br., p. 6. In addition, it submits that the goods are distinct and they move through different channels of trade. Finally, applicant points out that it now has acquired Registration No. 1,961,788 for the mark shown below³ for "ale, namely hand crafted ale freshly brewed for consumption in pubs and restaurants."



³ The registration contains the words NUTCRACKER FESTIVAL ALE SEASONAL, which do not reproduce well in the drawing. The registration disclaims the word "ale."

Applicant argues that its ownership of this registration indicates there would be no likelihood of confusion between its application and the cited registration.

Determining whether there is a likelihood of confusion requires application of the factors set forth in In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). In considering the evidence of record on these factors, we must keep in mind that "[t]he fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

In this case, applicant's and registrant's marks include the same word NUTCRACKER. The fact that applicant separates the words NUT and CRACKER does not change the commercial impression and the connotation of the two words is the same. Furthermore, the addition of the generic word "ale" is not significant. While we must consider marks in their entirety, disclaimed matter is often given less weight than other elements of a mark. Hilson Research Inc. v. Society for Human Resource Management, 27 USPQ2d 1423 (TTAB 1993).

Applicant's design does not serve to eliminate the likelihood of confusion. The Federal Circuit held that the addition of the words "The" and "Cafe" and a diamond-shaped design to registrant's DELTA mark still resulted in a likelihood of confusion. In re Dixie Restaurants, 105 F.3d 1405, 1406, 41 USPQ 1531, 1534 (Fed. Cir. 1997) (more weight given to common dominant word DELTA). See also In re Hyper Shoppes (Ohio), Inc., 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988) (BIGG'S and design for grocery and general merchandise store services found likely to be confused with BIGGS and different design for furniture); Giant Foods, Inc. v. Nation's Foodservice, Inc., 710 F.2d 1565, 218 USPQ 390, 395 (Fed. Cir. 1983) (Differences between GIANT HAMBURGERS and design and GIANT and GIANT FOODS and designs not sufficient to overcome the likelihood of confusion); Wella Corp. v. California Concept Corp., 558 F.2d 1019, 194 USPQ 419, 422 (CCPA 1977) (CALIFORNIA CONCEPT and surfer design likely to be confused with CONCEPT for hair care products). Here, inasmuch as applicant has described its mark as consisting of "a stylized design of a nutcracker's face" (Request for Reconsideration, dated December 12, 2000, p. 2), the design reinforces the word that is common to both marks, "nutcracker."

Also, differences in type styles between opposer's mark and applicant's design mark are not significant here because registrant's mark is in typed form and, thus, not limited to any special form. Squirtco v. Tomy Corp., 697 F.2d 1038, 1041, 216 USPQ 937, 939 (Fed. Cir. 1983); Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 USPQ2d 1842, 1847-48 (Fed. Cir. 2000).

Therefore, the next issue is whether the goods are related. There is certainly no rule that all alcoholic beverages are related. To determine whether the goods are related, we must look to the identification of goods in the application and registration. Dixie Restaurants, 41 USPQ2d at 1534; Canadian Imperial Bank of Commerce v. Wells Fargo Bank, 811 F.2d 1490, 1493, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987); Paula Payne Products v. Johnson Publishing Co., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973). Applicant's goods are "beer, ale, and malt liquor." Registrant's goods are identified simply as "liqueur." According to Federal regulations a liqueur or cordial is defined as follows:

[P]roducts obtained by mixing or redistilling distilled spirits with or over fruits, flowers, plants, or pure juices therefrom, or other natural flavoring materials, or with extracts derived from infusions, percolation, or maceration of such materials, and containing sugar, dextrose, or levulose, or a combination thereof, in an amount not less than 2½ percent by weight of the finished product.

27 CFR § 5.22(h).

Examples of liqueurs in the regulations include "sloe gin," "bourbon liqueurs," "rock and rye," "rum liqueur," "gin liqueur," and "brandy liqueur." 27 CFR § 5.22(h)(1)-(4). Registrant has not limited its liqueurs to any particular type.

It is not necessary that the respective goods be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is sufficient that the goods are related in some manner or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association or connection between the producers of the respective goods. See In re Melville Corp., 18 USPQ2d 1386 (TTAB 1991); In re International Telephone & Telegraph Corp., 197 USPQ 910 (TTAB 1978).

The evidence indicates that the applicant's and registrant's goods could be marketed in the same stores. See Applicant's Request for Reconsideration, Ex. 2 (beer, wine, liqueur, and other liquors sold in same drug store);

Registration Nos. 2,101,607; 2,185,374; 2,215,301; and 2,248,967 (registrations for retail stores services selling beer and liqueurs and/or liquor). Applicant's Request for Reconsideration, Ex. 2 (p. 2) shows that beer, wine, scotch, and whiskey are displayed and advertised together. In addition, the Examining Attorney has made of record several third-party registrations (Nos. 2,350,261; 2,162,683; and 2,223,486) to show that beer and liqueurs are sold by the same parties under the same trademarks.⁴ See In re Mucky Duck Mustard Co., 6 USPQ2d 1467, 1470 n.6 (TTAB 1988) (Although third-party registrations "are not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, [they] may have some probative value to the extent that they may serve to suggest that such goods or services are the type which may emanate from a single source").

In effect, the evidence shows that beer and liqueurs are sold in the same stores and are advertised together, and there is evidence that beer would be displayed with liquor. Finally, there is no evidence that the prospective purchasers of liqueurs, which would include sloe gin, rock and rye, bourbon liqueurs, etc., would not overlap with the

⁴ We have not considered the registrations that do not allege a date of use in commerce in the United States.

purchasers of beer. In a similar case involving the marks BRADOR for malt liquor and BRAS D'OR and design for cognac, the Board held:

We also believe that applicant's malt liquor is sufficiently related to opposer's Cognac brandy that, when sold under similar marks in the same channels of trade, such as bars, restaurants and liquor stores, confusion is likely. While we have no doubt that purchasers are not likely to consume a malt liquor thinking that it is Cognac brandy, in view of the similarities of the mark it is reasonable to assume that purchasers may believe that BRADOR malt liquor is another premium imported alcoholic beverage sold by the same company which sells expensive BRAS D'OR Cognac Brandy.

Schieffelin & Co. v. Molson Companies, 9 USPQ2d 2069, 2073

(TTAB 1989). See also Fleischmann Distilling Corp. v.

Maier Brewing Co., 314 F.2d 149, 136 USPQ 508, 514 (9th

Cir. 1963) (BLACK & WHITE scotch whiskey confusingly

similar to BLACK & WHITE beer; purchasers may believe that

beer may be produced under the supervision of the scotch

whiskey distiller or pursuant to some other arrangement

with them).

We are also aware of two cases in which our primary reviewing court and its predecessor did not find confusion between different alcoholic beverages. In the first one, the Federal Circuit determined that the mark RED STRIPE and design for beer was not confusingly similar to a design of a red stripe for wines and sparkling wines. In that inter

partes case, the Court was persuaded by the lack of actual confusion after ten years of simultaneous use, the difference in the marks, and the use of similar stripe marks on other beer and still wine products. G.H. Mumm & Cie v. Desnoes & Geddes Ltd., 917 F.2d 1292, 16 USPQ2d 1635, 1638-39 (Fed. Cir. 1990). In this ex parte case, actual confusion is much less relevant, the marks are very similar, and there is no evidence of other uses of the term "nutcracker" by other alcoholic beverage producers besides the registrations and application of record.

The second case involved the marks DUET on prepared alcoholic cocktails, some of which contained brandy, and DUVET for French brandy and liqueurs. National Distillers and Chemical Corp. v. William Grant & Sons, Inc., 505 F.2d 719, 184 USPQ 34 (CCPA 1974). The CCPA determined that DUET was a common word and DUVET was not. "We consider the sound and meaning substantially different and sufficiently so to preclude likelihood of confusion." Id. at 35. In the present case, the dominant part of the marks is the common word "nutcracker." While applicant includes a design, the design is of a nutcracker's face, which does not provide a basis to distinguish marks containing the word "nutcracker." Therefore, the marks are not

sufficiently different, as the marks DUET and DUVET were, so as to avoid a likelihood of confusion.

Applicant also argues that since it is now the owner of Registration No. 1,961,788 and the fact that these marks "have been simultaneously registered for years without confusion" supports the registration of applicant's mark. Applicant's Appeal Br., p. 9. Several points undercut the persuasiveness of this argument. One is that the words are not a very prominent part of this mark. In fact, they are barely visible in the drawing in the registration.



Even assuming that the words NUTCRACKER FESTIVAL ALE SEASONAL are visible when the mark is actually used, it is much less prominent in the design than applicant's mark. Second, applicant's identification of goods, beer, ale, and malt liquor, is much broader than the registration's identification of goods. Not only is the claimed registration limited to ale, it is even more specifically limited to "hand crafted ales freshly brewed for consumption in pubs and restaurants." Therefore, it would

never be sold in liquor stores, drug stores, and similar retail establishments and it would never appear in advertising as Applicant's Request for Reconsideration shows in Exhibit 2. The channels of trade are dramatically narrower. Third, the fact that there has been no actual confusion is not significant. It is unnecessary to show actual confusion in establishing likelihood of confusion. Giant Food, Inc. v. Nation's Foodservice, Inc., 710 F.2d 1565, 218 USPQ 390, 396 (Fed. Cir. 1983); J & J Smack Foods Corp. v. McDonald's Corp., 932 F.2d 1460, 18 USPQ2d 1889, 1892 (Fed. Cir. 1991). Moreover, an ex parte proceeding provides no opportunity for the registrant to show instances of actual confusion. Thus, applicant's ownership of the claimed registration does not overcome the likelihood of confusion.

Applicant devotes much of his brief to arguing that the registration is abandoned because of nonuse. Applicant has submitted additional evidence of alleged nonuse with its appeal brief, which we do not consider. 37 CFR 2.142(d). Even if this evidence were considered, it would be irrelevant in this proceeding. An applicant in an ex parte proceeding cannot attack the validity of a registration cited against it. It is presumed to be valid. Dixie Restaurants, 41 USPQ2d at 1534. If an applicant

believes a cited registration is no longer valid, its remedy is to file a petition to cancel the registration.

Finally, this decision comes down to a determination of whether prospective purchasers, when they encounter the marks NUTCRAKER for liqueur and NUT CRACKER ALE with a nutcracker design for beer, ale and malt liquor, sold in the same stores and advertised together, would believe that there was a relationship or association between the source of the two products? We believe that the answer is "yes" and therefore, we conclude that confusion is likely. To the extent we have doubts, we resolve them, as we must, in favor of the prior registrant and against the newcomer. Kenner Parker Toys v. Rose Art Industries, 963 F.2d 350, 355, 22 USPQ2d 1453, 1458 (Fed. Cir. 1992).

Decision: The refusal to register is affirmed.